

ST



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 09/754,879 | 01/05/2001 | Christian F. Bayne | D5407-111 304-22404-US | 5401 |
| 25397 | 7590 | 05/21/2004 | EXAMINER | |
| DUANE, MORRIS, LLP SUITE 3150 3200 SOUTHWEST FREEWAY HOUSTON, TX 77046 | | | THOMPSON, KENNETH L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3672 | |

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,879

Applicant(s)

BAYNE ET AL. *et*

Examiner

Kenn Thompson

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 7-10, 12-14 and 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5 Jan 01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 11, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Huber, U.S. 5,971,072.

Regarding claims 1 and 2, Huber discloses in figures 1-14 attaching at least one auxiliary conduit to a downhole assembly. Huber discloses providing a connection (101) to the conduit. Huber discloses running in the downhole assembly with the conduit to a desired location (50,51,55,56,57) in the well. Huber discloses tagging (via 20) into the downhole assembly and the connection of the conduit downhole on at least one subsequent trip into the well with a tubular having at least one auxiliary conduit extending along its length from the surface. Huber discloses communicating (via 16a) through the auxiliary conduit between the surface and the downhole assembly on a real time basis.

As to claim 3, Huber discloses plugging the connection (20) during the running in of the downhole assembly and auxiliary conduit; unplugging the connection with another trip into the well.

As to claim 4, Huber discloses performing the tagging in without rotation (col. 4, lines 10-16).

Art Unit: 3672

As to claim 5, Huber discloses selectively locking any connection resulting from the tagging in.

As to claim 6, Huber discloses configuring the auxiliary conduit adjacent the downhole assembly in a manner which permits monitoring (16a) the functioning of the downhole assembly.

As to claim 11, Huber discloses using the auxiliary cable or conduit to operate at least a portion of the downhole assembly.

As to claim 15, Huber discloses running the auxiliary conduit in a U-shaped path (820,824) so as to provide a pair of connections; extending the U-shaped path to the surface as a result of the tagging, an auxiliary conductor or cable attached to a tubular run in from the surface, into a respective connection on a subsequent trip into the wellbore.

As to claim 16, Huber discloses running at least one cable (15) and at least one conduit (110) auxiliary to the downhole assembly securing the cable to the conduit.

Allowable Subject Matter

Claims 7-10, 12-14 and 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including using a gravel pack screen and packer for the downhole assembly extending the cable or conduit through the packer to the connection.

The prior art of record does not disclose or suggest all the claimed subject matter including using fiber optic as the cable .

Art Unit: 3672

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Snider, U.S. 6,536,524; Mullen, U.S. 6,349,772 and Pringle et al., U. S. 6,237,683 disclose a similar method

Wolff et al., U.S. 3,741,300 discloses a similar screen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 703 306-5760. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 703 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14 May 2004

